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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,224	01/21/2004	Kia Silverbrook	WAL03US	1384

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AUSTRALIA

EXAMINER

COLILLA, DANIEL JAMES

ART UNIT	PAPER NUMBER
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2854

DATE MAILED: 06/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/760,224	Applicant(s) SILVERBROOK ET AL.	
	Examiner Daniel J. Colilla	Art Unit 2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2004 and 12 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/12/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 20-35, 39 and 43-47 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 20-35, 39 and 43-47 are drawn to a consumer tote. However, these claims do not further limit the structure of the consumer tote but instead recites structure of the environment in which applicant intends to use the consumer tote. Since no language further limiting the media cartridge these claims fail to further the parent claim, claim 1.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 36-38, 40-42 and 48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 36-38, 40-42 and 48, the statutory class of invention being claimed is unclear. The preambles begin by reciting “a consumer tote as claimed in claim 1” which would suggest that the claim is directed towards an apparatus. But then the claims continue with the phrase (or a similar phrase), “adapted for use in a method . . . comprising the steps of:” and the body of each

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respective claim recites a series of method steps. This would suggest that applicant is attempting to recite a method claim.

For purposes of prior art examination, these claims will be interpreted as apparatus claims.

Double Patenting

4. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

5. Claims 1-2 and 10-12 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S. Patent No. 6,991,098. This is a double patenting rejection.

6. Claim 3 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 2 of prior U.S. Patent No. 6,991,098. This is a double patenting rejection.

7. Claim 4 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 3 of prior U.S. Patent No. 6,991,098. This is a double patenting rejection.

8. Claim 5 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 4 of prior U.S. Patent No. 6,991,098. This is a double patenting rejection.

9. Claim 6 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 5 of prior U.S. Patent No. 6,991,098. This is a double patenting rejection.

10. Claim 7 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 6 of prior U.S. Patent No. 6,991,098. This is a double patenting rejection.

11. Claim 8 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 7 of prior U.S. Patent No. 6,991,098. This is a double patenting rejection.

12. Claim 9 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 8 of prior U.S. Patent No. 6,991,098. This is a double patenting rejection.

13. Claim 13 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 9 of prior U.S. Patent No. 6,991,098. This is a double patenting rejection.

14. Claim 14 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 10 of prior U.S. Patent No. 6,991,098. This is a double patenting rejection.\

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15. Claim 15 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 11 of prior U.S. Patent No. 6,991,098. This is a double patenting rejection.

16. Claim 16 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 12 of prior U.S. Patent No. 6,991,098. This is a double patenting rejection.

17. Claim 17 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 13 of prior U.S. Patent No. 6,991,098. This is a double patenting rejection.

18. Claim 18 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 14 of prior U.S. Patent No. 6,991,098. This is a double patenting rejection.

19. Claim 19 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 15 of prior U.S. Patent No. 6,991,098. This is a double patenting rejection.

Claim Rejections - 35 USC § 102

20. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

21. Claims 1-2 and 20-48 are rejected under 35 U.S.C. 102(b) as being anticipated by Taylor et al. (US 5,593,035).

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With respect to claim 1, Taylor et al. discloses a consumer tote including a disposable exterior 70 (note, while Taylor et al. is silent on the material of exterior 70, anything can be considered disposable because anything can be disposed of), a main access flap 74, and a pair of core access openings 100 and an interior in which is located a disposable core 18 (again, anything can be considered disposable) aligned with the access openings as shown in Figure 2 of Taylor et al.

With respect to claim 2, The access flap 74 is hinged at 86 as shown in Figure 3 of Taylor et al. for rotating between an open position (see Figure 3) and a closed position (see Figure 1). In the closed position the flap 74 restricts access to a gap 106 (see Figure 1) formed between flap 74 and an adjacent edge 104 of the exterior.

With respect to claims 20-35, 39 and 43-47, applicant has not recited any further structure of the consumer tote in these claims. Instead applicant has recited structure of other apparatus to be used with the consumer tote. Since the consumer tote has not been further limited in these claims, they are rejected along with their parent claim, claim 1.

With respect to claims 36-38, 40-42 and 48, these claims only further limit the claim by reciting a process of how the tote is to be used. Since this is an apparatus claim the method of how the tote is to be used does not add any further structural limitations of the tote. Therefore, these claims are rejected along with their parent claim, claim 1.

22. Claims 1-2, 4, 5, 8, and 18-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Harris et al. (US 5,161,685).

With respect to claim 1, Harris et al. discloses a consumer tote including a disposable exterior 42 (note, while Harris et al. is silent on the material of exterior , anything can be considered disposable because anything can be disposed of), a main access flap 46, and a pair of core access openings 44b,46b and an interior in which is located a disposable core c (again, anything can be considered disposable) aligned with the access openings as shown in Figure 5 of Harris et al.

With respect to claim 2, the access flap 46 is hinged for rotating between an open position (see Figure 5) and a closed position (Harris et al., col. 5, lines 8-13). In the closed position the flap 46 restricts access to a gap formed between flap 46 and an adjacent edge 44c of the exterior (Harris et al., col. 5, lines 23-26).

With respect to claims 4 and 18, Harris et al. discloses molded hubs 48 for supporting the core c as shown in Figure 5 of Harris et al.

With respect to claims 5 and 19, Figure 5 of Harris et al. shows that the openings 44b,46b are comprised of bearing surfaces (Harris et al., col. 5, lines 13-19).

With respect to claim 8, Harris et al. discloses an external coupling 50 that could be used to engage a rotating winding spindle.

Claim Rejections - 35 USC § 103

23. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

24. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor et al. (US 5,593,035) as applied to claim 1 above, and further in view of Crim (US 4,467,974).

Taylor et al. discloses the claimed tote except that he is silent on the material that it is made of. However, Crim discloses holder for a roll of paper that can be made of plastic, wood, fiberglass or any other suitable material having sufficient strength (Crim, col. 2, lines 35-41). These materials are all non-metallic and at least plastic and fiberglass can be considered textiles.

25. Claims 5-7 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harris et al. (US 5,161,685), as applied to claim 4 above, and further in view of Sirianni (US 5,413,220).

With respect to claims 5-6 and 19, Harris et al. discloses the claimed consumer tote except for each hub being surrounded by a bearing surface which locates the hub in a respective access opening. However, Sirianni teaches a supporting hub for a core C which has a surface that surrounds the hub and bears on the bottom of the interior of box B as shown in Figure 8 of Sirianni. In combination with Harris et al. the bearing surface taught by Sirianni would provide the support that locates the hubs in the access openings disclosed by Harris et al.. It would have been obvious to combine the teaching of Sirianni with the consumer tote disclosed by Harris et al. for the advantage of the energy attenuating support which protects the roll in the box from damage due to shock (Sirianni, col. 1, lines 6-12).

With respect to claim 7, the bearing surface taught by Sirianni is circular and is connected to the hub by spokes 44 as shown in Figure 2 of Sirianni.

26. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harris et al. (US 5,161,685), as applied to claim 8, and further in view of Kofler (US 4,697,756).

Harris et al. discloses the claimed tote except for the ring of teeth on the external coupling. However, Kofler discloses a coupling 26a for driving a hub that includes a ring of teeth as shown in Figure 1 of Kofler. It would have been obvious to combine the teaching of Kofler with the tote disclosed by Harris et al. for the advantage of providing a positive mechanical engagement in the coupling that prevents slipping of the coupling.

27. Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harris et al. (US 5,161,685), as applied to claim 1 above, and further in view of Jamet (EP 826618).

With respect to claim 10, Harris et al. discloses the claimed tote except for the handle that folds flat against the exterior. Harris et al. discloses a handle 121, but it does not fold flat. However, Jamet discloses a tote 4 with a handle 11,11 that folds flat against the exterior of the tote as shown in Figure 1 of Jamet and disclosed in the English abstract. It would have been obvious to combine the teaching of Jamet with the tote disclosed by Harris et al. for the advantage of a handle that can be folded out of the way when not in use to allow for easier storage or insertion of the tote into other devices.

With respect to claim 11, the handle is formed by two similar sub-units 11 which fold from a flat position adjacent the sides of the tote to a cooperating position in which a handle opening in each sub-unit 11 to form a grip as shown in Figure 1 of Jamet.

28. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harris et al. (US 5,161,685), as applied to claim 41 above, and further in view of Cocchi et al. (US 5,450,949).

Harris et al. in discloses the claimed tote except for the visible marker. However, Cocchi et al. teaches a roll of media that has a label 6 with a visible indicator 8 indicating proper placement of the reel relative to unwinding means. It would have been obvious to combine the teaching of Cocchi et al. with the tote disclosed by Harris et al. for the advantage of indicating to the user the proper orientation of the tote relative to an unwinding means. Furthermore, such a visible indicator is a basic instructional expedient that would have been obvious to one of ordinary skill in the art.

29. Claims 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harris et al. (US 5,161,685).

With respect to claim 14, Harris et al. discloses the claimed tote except that no specific dimension is disclosed. However, the dimensioning of a product to fit another apparatus would have been an obvious modification that could have readily been determined through routine experimentation by one of ordinary skill in the art. Additionally, it has been established that when the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device (see MPEP 2144.04, section IV, part A).

With respect to claim 16, while it is not known to the examiner if the tote disclosed by Harris et al. can hold 50 meters of wallpaper, if it cannot, then it is simply a matter of making the tote larger. Changes in dimension of the tote have been addressed above with respect to claim 14.

30. Claims 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harris et al. (US 5,161,685) in view of Takayama (US 6,520,395).

Harris et al. discloses the claimed tote except for the viewing window. However, Takayama discloses a tote 1 for containing a roll of media including a window (not shown) in the side sheet 4 or the lid 7 (Takayama, col. 9, lines 28-30). It would have been obvious to combine the teaching of Takayama with the tote disclosed by Harris et al. for the advantage of being able to view the inside of the tote to determine what type of media is inside or how much media is remaining.

31. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harris et al. (US 5,161,685) in view of Moggia (EP 327712).

Harris et al. discloses the claimed tote except for the adjacent edge of the exterior that includes a return lip. However, Moggia discloses an exterior edge, adjacent the gap, that includes a return lip 9 as shown below in Figures 1 and 4 of Moggia. It would have been obvious to combine the teaching of Moggia with the tote disclosed by Harris et al. for the advantage of using the cover 2 and the cooperating rim 9 together to press the paper down allowing a user to tear of a portion of the dispensed paper.

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32. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel J. Colilla whose telephone number is 571-272-2157. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on 571-272-2168. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

June 19, 2006



Daniel J. Colilla
Primary Examiner
Art Unit 2854